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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,126	09/21/2001	Stephen R. Schmidt	28748/37575	4200
4743	7590	01/18/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			CORCORAN, GLADYS J PIAZZA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/961,126

Applicant(s)

SCHMIDT, STEPHEN R.

Examiner

Gladys JP Corcoran

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED January 6, 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 10,11,16,17 and 35.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Gladys JP Corcoran  
Primary Examiner  
Art Unit: 1733

Continuation of 5. does NOT place the application in condition for allowance because:

As to the remarks section filed on January 6, 2005:

Applicant argues on pages 4 to 5 that the Specification is replete with references to a water supply and a starch supply which combine to form an adhesive and that such a combination is readily known by anyone in the industry. Whether combining starch and water is known in the art to form an adhesive is not the issue in the rejection in paragraph 3 of the prior Office Action filed on September 3, 2004. The claim 10 recites an apparatus where a water supply device applies water to only a plurality of crests and a starch supply device applies starch to only a plurality of crests and that "the water and starch combining to form an adhesive joining the first and second webs of medium together." Consequently the claim recites that the water from the water supply device is combined with the starch from the starch supply device to form an adhesive. Applicant's arguments and references to the Specification are directed to starch and water in general being combined and supplied together to the corrugated board in the art, while this may be so, this is not what is recited in the claim. Additionally, the test of the written description requirement is not of what is generally known in the art, but rather subject matter described in the original Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Throughout the Specification, the adhesive joining the layers is applied from the adhesive supply device (which may be a starch slurry) and the starch slurry heated such that the powdered starch granules burst, gelatinize, and form a glue (page 10, lines 16-17). In fact, the Specification even discloses that the water from the slurry is absorbed into the corrugated layer before the slurry becomes an adhesive (page lines 16-18). There is no disclosure that the water from the water supply device is combined with the starch supplied from the starch supply device to form an adhesive joining the first and second mediums of web together.

Applicant argues on page 5, that the Wallick references do not provide separate water and starch supply devices. Again, the claims are apparatus claims, the material worked upon does not further limit apparatus claims (see MPEP §2115). The Wallick reference discloses an applicator 48 which reads on Applicant's "water supply device" and a glue station 42 which reads on Applicant's "starch supply device".

Applicant argues on page 5, that the Examiner's statement that the resin applicator of Wallick is the same as the water supply device is an impermissible leap. As discussed above, these are apparatus claims, the material worked upon does not further limit apparatus claims (see MPEP §2115). The applicator 48 is fully capable of supplying water, which is all that is required in the current claims. In fact, the applicator 48 in Wallick does in fact apply water as the resinous material applies is in an aqueous solution (emulsion or latex), consequently water is applied through the device 48. Furthermore, the Specification does not define the wetting supply device as a particular structure any different from those in the references (see page 6 line 20 to page 7, line 3; page 7, line 20 to page 8, line 8; page 8, line 16 to page 9, line 4). The Specification also discloses that "a wetting agent such as water with or without adhesives is applied" (page 10, lines 11-12), further showing that the wetting agent supply device is not particular to just water nor has a particular structure just for water. Consequently, all the current limitations are met by the references as recited in the prior Office Action.

Applicant argues on page 6 that the Wallick references do not disclose many of the pending elements. As discussed in the rejections of the prior Office Action and the paragraphs above, all the current limitations of the claims are shown by the references.

Applicant argues on page 6 that Examiner's statement that the spraying device 6 of Swift is "capable of supplying water" is not sufficient for an obviousness rejection. Again, the claims are apparatus claims, the material worked upon does not further limit apparatus claims (see MPEP §2115). The structure and the function of the water supply device as claimed is no different than that shown by the references.

Applicant argues on pages 6 and 7 that there are structural differences between the pending claims and the prior art and that the resulting combination results in a significant improvement in the industry. Applicant does not state what the structural differences are nor the significant improvements in the industry. As discussed in the prior Office Action, all the limitations of the claims are met by the cited references.

Applicant is reminded that discourteous comments in papers are not taken lightly by the Office (see MPEP §714.25).

As to the declaration filed on January 6, 2005:

The declaration under 37 CFR 1.132 filed January 6, 2005 is insufficient to overcome the rejections of claim 10, 11, 16, 17 and 35 based upon Wallick '391, Wallick '458, Westphal, Miller, and/or Swift as set forth in the last Office action because:

For the claims rejected under 35 USC 102, objective evidence can not overcome claims anticipated by the prior art (see MPEP §706.02(b) for examples on how to overcome 35 USC 102 rejections).

For the claims rejected under 35 USC 103, the declaration does not provide sufficient objective evidence to overcome the rejections (see MPEP §716 for proper objective evidence). As to the substance of the declaration, the statements declared in the declaration are not germane to the currently recited claim limitations. Additionally, the declaration recites needs in the art without direct links to the claimed limitations that fulfill those needs.